

[Emphasis added.] This has not been done. In the instant Office Action, none of the Applicants' arguments set forth in the response filed on July 12, 2004 have been answered or refuted. The Examiner justifies his silence by stating in ¶ 5 of the action: "Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection." However, the foregoing statement has no basis in fact since the sole rejection (set forth in the preceding paragraph) is not a new ground of rejection, but rather is the same rejection that was made in ¶ 6 of the second non-final action mailed on April 9, 2004. In the April 9 action, claims 1, 3-11, 13-23, 49, 52, 54 and 55 (as well as claims 33, 41-48 and 50) were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Strand patent, which is the same rejection being made now.

Not only is the stated ground of rejection in the two actions identical, but the rationale set forth in support of this obviousness rejection is the same. In the April 9 action, the Examiner asserted that the Applicants had admitted that "[a] line of weakness is an alternative embodiment of the slit" (see ¶ 2) and that such an alternative embodiment is "an obvious variation in design" (see ¶ 6). Similarly, in the September 9 action, the Examiner quotes the statement in Applicants' specification that "lines of weakness may be employed in place of slits" and later concludes that "the use of the slit 20 in the present claimed invention is deemed to be a design consideration which fails to patentably distinguish over the

prior art of Strand". Since the grounds of rejections are the same, the failure to answer Applicants' arguments as set forth in the July 12 response is clearly improper.

The Applicants further traverse the Final Rejection because, like the second non-final rejection, it again relies on the premise that the Applicants have made an admission in their specification that a slit is an obvious alternative to a line of weakness. But close scrutiny of the quoted statements relied upon by the Examiner reveals that this premise is false. On page 3 of the action, the Examiner quotes from Applicants' specification and underlines two clauses for emphasis, but makes no statement as to why the two clauses have been underlined and what the relationship between the two emphasized clauses might be. In fact, there is no relationship. The first emphasized clause ("Alternatively, lines of weakness may be employed in place of slits, . . .") merely states that in alternative embodiments, either slits or lines of weakness may be used. The second emphasized clause ("Again, such a line of weakness may comprise a line of spaced slits, a line of spaced perforations, a continuous or discontinuous score-line of thinned header material, a continuous or discontinuous line of pre-weakened header material, or any equivalent structure for providing a line of preferential tearing.") merely states that lines of preferential tearing having a structure equivalent to the examples given may be used. Contrary what the Examiner may be implying, the quoted text does not state that a slit is a

structural equivalent to a line of weakness or preferential tearing. If this is what the Examiner was thinking, but carefully avoided saying, then the Examiner is simply mistaken. If this is not what the Examiner was thinking, then the Applicants respectfully request that the Examiner expressly state the reason for the underlinings in the quoted text and how the underlined clauses support the Examiner's theory of rejection. The Applicants should not have to guess what is the rationale underlying the rejection!

The next sentence in the Final Rejection, following the quote from Applicants' specification, is even more mystifying. The action reads: "Moreover, it appears that Strand's package would perform equally well with lines of weakness 13, for providing an easy way to open the package when the consumer tries to tear the header open." Since the embodiments in Strand undeniably have lines of weakness, the Applicants do not understand why the Examiner asserts that Strand's package "would perform equally well with lines of weakness". The Applicants concede that a line of weakness will perform equally well with a line of weakness, but question the significance of such a *non sequitur*. How does it fit in the rationale for rejection. Again clarification is requested.

The Examiner then summarily concludes with the statement: "Accordingly, the use of the slit 20 in the present claimed invention is deemed to be a design consideration which fails to patentably distinguish over the prior art of Strand." [Emphasis

added.] The use of the term "Accordingly" gives the impression that this statement is logically based on statements preceding it. But what that logical basis might be is not apparent and is nowhere to be found when one critically examines the preceding statements, to wit, (1) the underlining of disconnected clauses in a quote from Applicants' specification; and (2) a *non sequitur*. The Applicants respectfully request clarification of the premises for the deduction that substituting a slit for a line of weakness would have been obvious.

The truth of the matter is that in the second non-final office action, the Examiner failed to lay out a *prima facie* case for obviousness, and that error has been repeated in the instant Final Rejection. While the Applicants, in response to the second non-final action, pointed out this failure and identified the elements of a *prima facie* case that were lacking, the Examiner has failed to cure these omissions in the latest action and instead has simply mistakenly asserted that a "new ground of rejection" was being made. On the contrary, the previous erroneous ground of rejection has been simply repeated.

Inspection of Applicants' specification reveals not an admission that a slit is the functional equivalent of a line of weakness, but rather the teaching that "a single inclined continuous slit is the most preferred embodiment since no tearing is required along the inclined line". [page 8, lines 2-4.] In other words, the Applicants clearly disclosed the a slit is preferred, not equivalent, to a line of weakening. This is

because a line of weakening may not work properly every time. When the consumer pulls on the header and the tear meets the curve of the line of weakening, the film - due to its orientation properties - may continue to tear off straight across the package at a point above the profile and the slider clip. This makes the package difficult to use.

Nor does Applicants' specification contain any discussion of obviousness, let alone any admission that a slit is an obvious variation of a line of weakness. If the Examiner concedes that the Applicants have not admitted that a slit is an obvious variation of a line of weakness, then the Examiner cannot rely on Applicants' teaching of a slit in his obviousness rejection. To do so would mean that the Examiner is using Applicants' own invention as prior art. This is clearly improper. The gist of the obviousness rejection is that the Applicants teach substituting a slit for a line of weakness, therefore it would be obvious to substitute a slit for the line of weakness in Strand. Such an obviousness rejection cannot stand. The claimed invention must be obvious in view of prior art, not in view of itself!

The third criterion for establishing a *prima facie* case of obviousness is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. The reason why the Final Rejection combines Applicants' own teaching with the teaching of Strand is that Strand does not teach using a slit. Consequently, as set forth in Applicants' response to

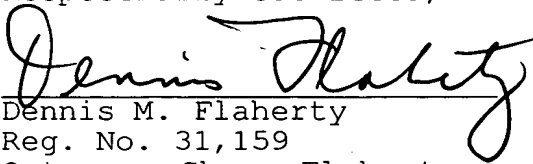
the second non-final action, the Examiner cannot make a *prima facie* case of obviousness based on Strand alone because Strand does not suggest using a slit in place of the line of weakness. On the contrary, Strand teaches away from using a slit because Strand states that "the zipper assembly 20 [is] hermetically sealed within the tear off portion 11." [col. 8, lines 58-59] This could not be true if the tear off portion had slits because slits do not allow for a hermetic seal. Therefore, the third criterion for establishing a *prima facie* case of obviousness has not been satisfied.

In view of the foregoing, no *prima facie* case of obviousness has been made and the obviousness rejection based on Strand should be withdrawn.

The Applicants submit that this application is now in condition for allowance. Reconsideration of the application and allowance of claims 1, 3-11, 13-22, 49, 52, 54 and 55 are hereby requested. Since it is believed that generic claims are now allowable, examination and allowance of claims 12, 23, 51 and 53 are also requested, which were previously withdrawn from further consideration.

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Respectfully submitted,


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